



## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Richard Torczon  
Telephone: (703) 308-9797  
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MAILED

OCT 1 - 2002

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Applicants: BENNEKER  
Application No.: 09/200,743  
Filed: 11/30/98  
For: 4-PHENYLPYPERIDINE COMPOUNDS  
Accorded benefit: 08/872,023, filed 06/10/97,  
now Patent No. 5,874,447, granted 02/23/99

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,009.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

  
RICHARD TORCZON  
Administrative Patent Judge

# INTERFERENCE DIGEST

Interference No. 105,009

Paper No. 27

Name: Franciscus B.G. Benneker et al.

Serial No.: 09/200,743

Patent No.

Title: 4-PHENYLPIPERIDINE COMPOUNDS

Filed: 11/30/98

Interference with Craig et al.

## DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

## FINAL DECISION

Board of Patent Appeals and Interferences, FAVORABLE Dated, 5/25/04

\_\_\_\_\_  
Court, \_\_\_\_\_ Dated, \_\_\_\_\_

## REMARKS

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\_\_\_\_\_  
\_\_\_\_\_

This should be placed in each application or patent involved in interference in addition to the interference letters.

BOX INTERFERENCE  
WASHINGTON DC 20231  
703-308-9797  
703-305-0942 (fax)

Paper 1

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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**SMITHKLINE BEECHAM PLC**  
(6,063,927 and 09/469,902),  
Junior Party,

v.

**SYNTHON BCT TECHNOLOGIES, LLC**  
(09/200,743),  
Senior Party.

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Patent Interference No. 105,009

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**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the captioned parties. Details of the applications, patent, count, and claims designated as corresponding to the count appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Administrative patent judge assigned  
to administer the interference**

The interference has been assigned to Sally Gardner-Lane. 37 CFR § 1.610. Richard Torczon will administer the interference through **15 November 2002**.

**Part C. Standing order**

A Trial Section STANDING ORDER (Paper 2) accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**

A telephone conference call to set dates for action in this interference is scheduled for **2 p.m.** (Eastern) on **26 November 2001**. (The Board will initiate the call.)

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE. Counsel should discuss the order by telephone prior to the telephone conference call and reach an agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine months. Counsel should be prepared to justify any request for a shorter or longer period.

Electronic filing

The Board of Patent Appeals and Interferences encourages filing papers electronically. The parties should review the order setting procedures for electronic filing in University of New Mexico v. Fordham University, Interference No. 104,761 (2001) posted at:

<http://www.uspto.gov/web/offices/dcom/bpai/its/104761-021.pdf>

and be prepared to discuss whether they would be willing to file papers electronically.

**Part E. The parties to this interference**

Junior Party

**Inventors:** Andrew Simon CRAIG,  
Victor Witold JACEWICZ, and  
Michael URQUHART, all of the UNITED KINGDOM

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**Patent:** 09/299,060, filed 23 April 1999 (6,063,927, issued 16 May 2000)

**Title:** Paroxetine derivatives

**Priority benefit:** UK 9902935.7, filed 10 February 1999

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**Assignee:** SmithKline Beecham plc

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**Application:** 09/469,902, filed 22 December 1999

**Title:** Novel compound<sup>1</sup>

**Priority benefit:** 09/299,060, filed 23 April 1999  
UK 9902935.7, filed 10 February 1999

**Assignee:** None of record

**Attorneys:** See last page

**Address:** See last page

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<sup>1</sup> This title does not come even close to complying with 37 C.F.R. §1.72(a).

Senior Party

**Inventors:** Franciscus Bernardus Gemma BENNEKER,  
Frans Van DALEN,  
Jacobus Maria LEMMENS, and  
Theodorus Hendricus Antonium PETERS, all of the NETHERLANDS; and  
Frantisek PICHA of the CZECH REPUBLIC

**Application:** 09/200,743, filed 30 November 1998

**Title:** 4-Phenylpiperidine compounds

**Priority benefit:** 08/872,023, filed 10 June 1997 (5,874,447, issued 23 February 1999)

**Assignee:** Synthon BCT Technologies LLC

**Attorneys:** See last page

**Address:** See last page

**Part F. Count and claims of the parties**

Count 1

An isolated compound of 6,063,927 claim 1.<sup>2</sup>

The claims of the parties are:

SKB 902: 155-203

SKB 927: 1-4

Synthon: 30-38

The claims corresponding to Count 1:

SKB 902: 155-203<sup>3</sup>

SKB 927: 1 and 3

Synthon: 30-38

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<sup>2</sup> 1. Paroxetine methanesulfonate in crystalline form having the following characteristic IR peaks:  
1063, 1194, 1045, 946, 830, 601, 554, and 539±4 cm-1.

<sup>3</sup> The examiner provided inconsistent explanations of what corresponds. The Form PTO-850 says "Claims 64-113", none of which appear to be pending. The attached explanation provides reasons for corresponding claims 155-158, 160-181, and 183-203, but no reason why claims 159 and 182 do not correspond. Assuming the correctness of the other claim correspondence, the exclusion of these claims is inexplicable.

The claims not corresponding to Count 1:

SKB 902: None

SKB 927: 2 and 4

Synthon: None

**Part G. Heading to be used on papers**

Addendum 1 provides the heading that shall be used on all papers filed in the interference. See § 18 of the STANDING ORDER.

**Part H. Summary of dates for taking action**

Addendum 3 provides a list of dates and times for taking action set in the STANDING ORDER

**Part I. Order form for requesting file copies**

Addendum 2 is an order form for requesting file copies. Use of the form will expedite the processing of your request.

RICHARD TORCZON  
Administrative Patent Judge

Enclosures:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference

Copy of order used for setting times for taking action in the priority phase of the interference

Form PTO-850

Copy of U.S. Patent 6,063,927

Copy of the application claims for: 09/200,743 and 09/469,902

Interference No. 105,009  
SmithKline Beecham plc v. Synthon BCT Techs., LLC

Paper 1  
Page 6

cc (via overnight carrier):

Counsel for SmithKline Beecham plc:

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**ADDENDUM 1**

Filed on behalf of: Party \_\_\_\_\_

Paper No. \_\_\_\_\_<sup>4</sup>

By:           Name of lead counsel  
              Name of backup counsel  
              Street address  
              City, State, and ZIP Code  
              Tel:  
              Fax:

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**  
(Administrative Patent Judge Gardner-Lane)

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**SMITHKLINE BEECHAM PLC**  
(6,063,927 and 09/469,902),  
Junior Party,

v.

**SYNTHON BCT TECHNOLOGIES, LLC**  
(09/200,743),  
Senior Party.

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Patent Interference No. 105,009

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**TITLE OF PAPER**

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<sup>4</sup> Leave blank for the Board to insert the paper number when the paper is entered into the administrative record.

**ADDENDUM 2**

**FILE COPY REQUEST**  
**Patent Interference No. 105,009**

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

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Telephone, including area code: \_\_\_\_\_

**ADDENDUM 3**

**SUMMARY OF DATES FOR TAKING ACTION**

Dates and times for taking action are set in the following sections of the STANDING ORDER:

1.     § 7 - date for identifying lead and backup counsel.
2.     § 8 - date for identifying any real party in interest.
3.     § 9 - date for requesting copies of involved and benefit applications and patents.
4.     § 17 - date for filing list of preliminary motions to be filed.
5.     § 19 - date for accomplishing certain discovery.
6.     § 20 - date for filing clean copy of claims.
7.     § 21 - date for filing clean copy of claims in cases with drawings or claims containing a means-plus-function limitation.
8.     § 23 - times for filing oppositions to Rule 635 motions and times for filing replies to oppositions.
9.     § 33 - time for objecting to admissibility of evidence.
10.    § 34 - time for serving supplemental affidavits or evidence to respond to an objection to admissibility of evidence.
11.    § 35 - times when cross-examination can take place.
12.    § 45 - times for taking action with respect to settlement discussions